

REMARKS/ARGUMENTS

Amendments were made to the specification to correct errors and to clarify the specification. No new matter has been added by any of the amendments to the specification.

Claims 1-5 and 7 are pending in the present application. Claims 1-5 and 7 were amended; and no claims were added or cancelled. Support for the amendments to the claims may be found at least in Figure 7 and in the Specification in at least the passage on page 18, line 4 through page 21, line 22. Reconsideration of the claims is respectfully requested.

Applicants wish to thank Examiner Dao for participating in a phone conference on August 19, 2008 and for providing guidance regarding the amending of claim 1 in faxes exchanged prior to the phone conference. As was agreed in the phone conference, the currently amended claim 1 appears to overcome the cited prior art, however, a further search still needs to be made.

The Final Office Action objected to the drawings, specifically to Figure 7, stating that "in light of specification, page 21, lines 12-16, both block 732/YES and block 706/NO would proceed to block 728 (not below block 728)." Applicants have amended the specification, lines 12-16 so that the text now correctly reads as Block 730, meaning that both block 732/YES and block 706/NO would proceed to block 730, or below block 728. Therefore, as Applicants now believe that the specification and Figure 7 agree, Applicants have not amended Figure 7.

The Final Office Action objected to the term DB2 on page 12 of the Specification, in that acronyms should be spelled out the first time they appear in the Specification. However DB2 is a registered trademark of the International Business Machines Corporation. Thus, Applicants have amended a portion of the Specification on page 12 to indicate that DB2 is a registered trademark of the International Business Machines Corporation.

I. 35 U.S.C. § 103, Obviousness

The Final Office Action has rejected claims 1-5 and 7 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,948,059 to *Sprecher et al.* (hereinafter "*Sprecher*") in view of "Tool to Facilitate Testing of Software to Insure Compatibility", IBM Technical Disclosure Bulletin, April 1988 (hereinafter "Bulletin"). This rejection is respectfully traversed.

Regarding this rejection, the Final Office Action states:

Claim 1:

*Sprecher discloses a method for testing the compatibility of software modules, the method comprising the computer implemented steps of:
responsive to receiving a request to install a new software module in a data processing system (e.g., col.2: 3-12; col.5: 36-45),*

performing an inventory on an existing set of software modules resident in the data processing system (e.g., FIG. 5, block 52 “Review Available Component Table”, col.7: 5-19; and details of said table in FIG. 4, col.6: 20-54);
referring to a knowledge base of software modules to determine whether the new software module is known to function compatibly with the existing set of software modules (e.g., FIG. 5, block 50 “Read next Required Component List in col.5: 52-67)l
responsive to a determination that the new software module is not known to function compatibly with the existing set of software modules (e.g., FIG. 5, block 66 “Hit? NO”, col.7: 20-41),
referring to the knowledge base of the software modules to determine whether the new software module is known to function incompatibly with the existing set of software modules (e.g., FIG. 5, block 72, col.7: 42-59); and
responsive to a determination that the new software module is not known to function incompatibly with the existing set of software modules (e.g., FIG. 5, block 84 →NO, col.7: 60 – col.8: 8),
loading the new software module in a data processing system in combination with the existing set of software modules (e.g., FIG. 5, block 84 “Compatible?” NO→86→92, col.8: 1-44).

Final Office Action dated May 23, 2008 p. 5 (emphasis in original).

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). “*Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).”

Currently amended independent claim 1 recites:

1. A method for testing the compatibility of software modules, the method comprising computer implemented steps of:
 responsive to receiving a request to install a new software module in a data processing system, performing an inventory on an existing set of software modules resident in the data processing system;

referring to a knowledge base of software modules to determine whether the new software module is known to function compatibly with each software module in the existing set of software modules;

responsive to a determination that the new software module is not known to function compatibly with each software module in the existing set of software modules, determining whether to test the new software module in a test data processing system in combination with the existing set of software modules;

responsive to a determination to test the new software module in the test data processing system in combination with the existing set of software modules, identifying an operating environment of the data processing system;

installing the new software module, the identified environment, and the existing set of software modules on the test data processing system;

testing the new software module in combination with the existing set of software modules on the test data processing system;

responsive to a test result indicating that the new software module is compatible with the existing software modules, adding a new combination indicating the compatibility to the knowledge base; and

installing the new software module in the data processing system.

Specifically, Applicants submit that at least the features of “referring to a knowledge base of software modules to determine whether the new software module is known to function compatibly with each software module in the existing set of software modules,” “responsive to a determination that the new software module is not known to function compatibly with each software module in the existing set of software modules, determining whether to test the new software module in a test data processing system in combination with the existing set of software modules,” “responsive to a determination to test the new software module in the test data processing system in combination with the existing set of software modules, identifying an operating environment of the data processing system,” “installing the new software module, the identified environment, and the existing set of software modules on the test data processing system,” “testing the new software module in combination with the existing set of software modules on the test data processing system,” and “responsive to a test result indicating that the new software module is compatible with the existing software modules, adding a new combination indicating the compatibility to the knowledge base,” are not taught or suggested by the combination of *Sprecher* in view of *Bulletin*.

Sprecher teaches a method of checking to see if pre-requisite software is installed on system when installing a software module. Applicants submit that determining whether a software module required to be present in order to install another software module is actually present in a set of software models is not the same as determining whether the software module being installed functions compatibly with the software modules that are already present on the system. That is, *Sprecher* teaches determining that the software can be installed, not determining whether the software functions compatibly with the other software. The distinction is important as software may be able to be installed on a system and still not be compatible with other software on the system. Therefore, *Sprecher* fails to teach or suggest the

feature of “referring to a knowledge base of software modules to determine whether the new software module is known to function compatibly with each software module in the existing set of software modules,” as recited in claim 1.

Further, no passage of *Sprecher* teaches, suggests or hints at the feature of “responsive to a determination that the new software module is not known to function compatibly with each software module in the existing set of software modules, determining whether to test the new software module in a test data processing system in combination with the existing set of software modules,” as recited in claim 1. *Sprecher* is silent in regards to testing of the software module. Therefore, logically, *Sprecher* cannot teach or suggest the feature of “responsive to a determination that the new software module is not known to function compatibly with each software module in the existing set of software modules, determining whether to test the new software module in a test data processing system in combination with the existing set of software modules.”

Additionally, *Sprecher*, column 5, lines 45-67, is cited as teaching “adding a new combination indicating the compatibility to the knowledge base.” However, the cited passage of *Sprecher* teaches that list of software modules is kept and that the list indicates whether a current version of a software module is compatible with prior versions of the same software module. Thus, the passage does not teach anything about adding a new combination that indicates the compatibility of the new software module, the software module to be installed, with the existing set of software modules. Thus, *Sprecher* fails to teach or suggest the feature of “responsive to a test result indicating that the new software module is compatible with the existing software modules, adding a new combination indicating the compatibility to the knowledge base.”

Additionally, *Sprecher* also fails to teach or suggest the features of “responsive to a determination to test the new software module in the test data processing system in combination with the existing set of software modules, identifying an operating environment of the data processing system” and “installing the new software module, the identified environment, and the existing set of software modules on the test data processing system.” The Final Office Action cites to *Sprecher* column 6, lines 55 through 67 and column 7, lines 6 through 31 as teaching these features. However, the two cited passages of *Sprecher* merely teach that if a pre-requisite for software module is not present on a data processing system, the pre-requisite software module is searched for. If found, the pre-requisite software module is loaded onto the data processing system and an entry is made into a software resource list indicating the added pre-requisite software module.

Further, Bulletin fails to cure the deficiencies of *Sprecher*. The Bulletin is cited as teaching “testing the new software module in a test data processing system in combination with the existing set of software modules.” The Bulletin does discuss a “sniff test”. However, this sniff test comprises using a

portion of available software and DOS configurations out of all the possible combinations of available software and DOS configurations to perform the test. Thus, the test is not actually performed in an environment that comprises “the existing set of software modules.” Further, claim 1 has been amended to recite the feature of “responsive to a determination that the new software module is not known to function compatibly with each software module in the existing set of software modules, determining whether to test the new software module in a test data processing system in combination with the existing set of software modules.” Nothing in the Bulletin teaches making a determination. Rather, the Bulletin merely discuss procedures for performing a sniff test. Thus, the Bulletin fails to teach or suggest the feature of “responsive to a determination that the new software module is not known to function compatibly with each software module in the existing set of software modules, determining whether to test the new software module in a test data processing system in combination with the existing set of software modules.”

Furthermore, nothing in the Bulletin teaches or suggests the features not taught by *Sprecher*, the features of referring to a knowledge base of software modules to determine whether the new software module is known to function compatibly with each software module in the existing set of software modules,” “responsive to a determination to test the new software module in the test data processing system in combination with the existing set of software modules, identifying an operating environment of the data processing system,” “installing the new software module, the identified environment, and the existing set of software modules on the test data processing system,” “testing the new software module in combination with the existing set of software modules on the test data processing system,” and “responsive to a test result indicating that the new software module is compatible with the existing software modules, adding a new combination indicating the compatibility to the knowledge base.” The Bulletin does not teach a knowledge base or checking a knowledge base or adding entries to a knowledge base. Nothing in the Bulletin teaches or suggests identifying a specific environment that the new software module is to be installed in and then replicating that environment, plus the existing set of software modules installed on the data processing system in a test data processing system and installing the new software module on the test data processing system to test the compatibility of the new software modules with the environment and the existing set of software modules.

Additionally, as stated in the phone conference on August 19, 2008, the currently amended claim 1 appears to overcome the cited prior art.

Therefore, for at least the reasons set forth above, Applicants submit that claim 1 is in condition for allowance due to the fact that the combination of *Sprecher* in view of Bulletin fails to render claim 1 obvious, as the combination of *Sprecher* in view of Bulletin fails to teach or suggest all the features of claim 1, as recited in claim 1. Since claims 2-5 and 7 depend from and further restrict claim 1, the same

distinctions between the combination of *Sprecher* in view of *Bulletin* and the claimed invention in claim 1 applies for these claims as well.

Therefore, the rejection of claims 1-5 and 7 under 35 U.S.C. § 103 has been overcome.

II. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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